

09/829,708

9

P-5686U1-C1

REMARKS

Reconsideration of the present application and entry of the amendment are respectfully requested. Claims 1, 3, 5, 7 to 11, 13, 15 to 17, 19 to 21, 23 to 25, 30 to 33, 35 and 37 are currently pending, claim 37 has been canceled, and no claims have been amended.

The Office Action mailed May 4, 2004 addressed claims 1, 3, 5, 7 to 11, 13, 15 to 17, 19 to 21, 23 to 25, 30 to 33, 35 and 37. Claims 1, 3, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21, 23 to 25, 30, 32, 33 and 37 were rejected, claim 10 was objected to, and claims 31 and 35 was allowed.

Claim 37 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 37 has been canceled by this Amendment. Applicants respectfully submit that this overcomes the rejection and request that the Examiner reconsider and withdraw the rejection of claim 37 under 35 U.S.C. § 112, first paragraph.

Claims 1, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21 and 33 were variously rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. (US 5,725,442) in view of Schenk (US 4,085,937). The Examiner stated that one having ordinary skill in the art would have found it obvious to have incorporated hollow spheres into any layer of the core of Higuchi et al., as taught by Schenk, in order to control the density of the golf ball.

Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. Higuchi et al. discloses a multi-layer golf ball having a multi-layer core and a multi-layer cover. The inner core and outer cover have specific hardness properties, and the combination of layers provides for an improved golf ball. Higuchi does not disclose a density reducing filler in the core or core layer. Schenk discloses two piece golf balls having a low specific gravity so that the golf ball floats in water. Schenk does not disclose a multi-layer core or a multi-layer cover.

Applicants respectfully submit that contrary to the assertions of the Examiner, there is no motivation to combine Higuchi et al., which discloses and teaches golf balls having four pieces or more and specific properties for at least the inner core and outer

09/829,708

10

P-5686U1-C1

cover, with Schenk, which teaches two piece floater golf balls. One skilled in the art would not be motivated to make the golf ball of Higuchi et al. using the microspheres of Schenk which reduce the density of the core of a two piece ball. Applicants respectfully submit that the Examiner has shown no motivation, teaching or suggestion to combine Schenk with Higuchi et al.

For at least these reasons, Applicants respectfully submit that claims 1, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21 and 33 are not obvious under 35 U.S.C. § 103(a) over Higuchi in view of Schenk. Applicants therefore respectfully request that the rejection of claims 1, 5, 7 to 9, 11, 13, 15 to 17, 19 to 21 and 33 under 35 U.S.C. § 103(a) as obvious over Higuchi in view of Schenk be reconsidered and withdrawn.

Claims 23, 24 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. (US 5,725,442) in view of Schenk (US 4,085,937) and further in view of Sullivan et al. (US 5,803,831).

Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. As discussed above, Applicants respectfully submit that the Examiner has shown no motivation, teaching or suggestion to combine Schenk with Higuchi et al. The addition of Sullivan et al. does not cure the deficiency of Higuchi et al. in view of Schenk.

For at least these reasons, Applicants respectfully submit that claims 23, 24 and 32 are not obvious under 35 U.S.C. § 103(a) over Higuchi et al. in view of Schenk and further in view of Sullivan et al. Applicants therefore respectfully request that the rejection of claims 23, 24 and 32 under 35 U.S.C. § 103(a) as obvious over Higuchi et al. in view of Schenk and further in view of Sullivan et al. be reconsidered and withdrawn.

Claims 25 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. (US 5,725,442) in view of Schenk (US 4,085,937) and further in view of Calabria et al. (US 5,733,428).

Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. As discussed above, Applicants respectfully submit that the Examiner has shown no motivation, teaching or suggestion to combine Schenk with

09/829,708

11

P-5686U1-C1

Higuchi et al. The addition of Calabria et al. does not cure the deficiency of Higuchi et al. in view of Schenk.

For at least these reasons, Applicants respectfully submit that claims 25 and 30 are not obvious under 35 U.S.C. § 103(a) over Higuchi et al. in view of Schenk and further in view of Calabria et al. Applicants therefore respectfully request that the rejection of claims 25 and 30 under 35 U.S.C. § 103(a) as obvious over Higuchi et al. in view of Schenk and further in view of Calabria et al. be reconsidered and withdrawn.

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Egashira et al. (US 5,439,227) in view of Schenk (US 4,085,937). The Examiner stated that one having ordinary skill in the art would have found it obvious to have incorporated hollow spheres into any layer of the core of Egashira et al., as taught by Schenk, in order to control the density of the golf ball.

Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. Egashira et al. discloses a multi-layer golf ball having a multi-layer core and a cover. The outer core comprises a polyester thermoplastic material, and it may also contain materials to increase the weight, such as zinc oxide or barium sulfate. Egashira et al. does not disclose a density reducing filler in the core or core layer. Schenk discloses two piece golf balls having a low specific gravity so that the golf ball floats in water. Schenk does not disclose a multi-layer core or a multi-layer golf ball.

Applicants respectfully submit that contrary to the assertions of the Examiner, there is no motivation to combine Egashira et al., which discloses and teaches golf balls having at least three pieces or more and specific properties for at least the outer core, with Schenk, which teaches two piece floater golf balls. One skilled in the art would not be motivated to make the golf ball of Egashira et al. using the microspheres of Schenk which reduce the density of the core of a two piece ball. Applicants respectfully submit that the Examiner has shown no motivation, teaching or suggestion to combine Schenk with Egashira et al.

09/829,708

12

P-5686U1-C1

For at least these reasons, Applicants respectfully submit that claim 3 is not obvious under 35 U.S.C. § 103(a) over Egashira et al. in view of Schenk. Applicants therefore respectfully request that the rejection of claim 3 under 35 U.S.C. § 103(a) as obvious over Egashira et al. in view of Schenk be reconsidered and withdrawn.

Claim 10 was objected to by the Examiner as dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As previously discussed, Applicants respectfully submit that claim 5 is allowable, therefore, claim 10, which depends from claim 5, is also allowable. Applicants respectfully request that the Examiner withdraw the objection to claim 10.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicants respectfully request reconsideration and allowance of each of the presently objected and rejected claims, claims 1, 3, 5, 7 to 11, 13, 15 to 17, 19 to 21, 23 to 25, 30 to 33, 35 and 37. Applicants respectfully request allowance of claims 1, 3, 5, 7 to 11, 13, 15 to 17, 19 to 21, 23 to 25, 30 to 33 and 35, the claims currently pending.

Respectfully submitted,

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Date: July 30, 2004

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